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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/738,659 10/30/96 MOTOYAMA

T 5244-051-2X-

EXAMINER

022850 LM02/0104
OBLON SPIVAK MCCLELLAND MAIER & NUESTADT
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1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON VA 22202

ART UNIT	PAPER NUMBER
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2756
DATE MAILED:

01/04/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 6/7/99 and 10/18/99.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 10, 12-19, 30, 38-44, 52-61 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 10, 12-19, 30, 38-44, 52-61 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review

Notice of Informal Patent Application, F

1. Examiner withdraw Supplemental Examiner Answer Paper No. 20 due to Patent Examining Procedural error. As a result of this error, the Supplemental Reply Brief filed on 10/17/99 will not be entered because of the rules in MPEP.

2. In view of the reply brief filed on June 07, 1999, PROSECUTION IS HEREBY REOPENED. A rebuttal to the Reply Brief is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

3. In the Reply Brief filed on June 07, 1999, applicant argued in substance that

- (A) Applicant argues that Kraslavsky et al (Kraslavsky) is directed to a high speed system for transmitting real-time or near-real-time status information. Modifying

Kraslavsky to operate using Internet electronic mail which may be quite slow would be contrary to the teachings of Kraslavsky.

As to point (A), Kraslavsky's invention is to eliminate the necessity of dedicating a personal computer to manage a peripheral such as a printer by providing an apparatus for interfacing the printer to a LAN (Kraslavsky, Field of the Invention, col. 1 lines 14-23). Obviously, Kraslavsky does not teach improving system speed by connecting the printer on LAN because a computer has a printer connected directly on the computer's parallel port provides the best real-time or near real time for status information compare to printer connected on LAN. Therefore, combining Cohn's teaching to use Internet electronic mail to manage Kraslavsky's peripheral without dedicating a personal computer enhances Kraslavsky's invention.

(B) Applicant argues that electronic mail has historically been for the transmission of text messages among computer users. Therefore, one of ordinary skill in the art at the time the invention was made would not utilize e-mail to transmit the type of information which is exchanged in Kraslavsky.

As to point (B), Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, or video transmission capabilities that can communicate compound message to each others using Internet

electronic mail message format (col. 8 lines 36-65, and col. 15 lines 65 - col. 16 line 36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize Internet electronic mail to transmit many different types of information including the type of information which is exchanged in Kraslavsky among various source and destination message systems because it would allow any type of messages to be transferred globally between any devices.

© Applicant argues that Kraslavsky already provide a well known standard such as TCP/IP (e.g., a global standard) for exchanging messages and performing electronic communication. Thus, as Kraslavsky already contain TCP/IP global standard for exchanging messages, it would not have been obvious to modify Kraslavsky to utilize Internet electronic mail to transfer messages globally between devices as this function is already available within Kraslavsky.

As to point (C), Applicant incorrectly thinks that Internet electronic mail is not part of TCP/IP standard. It is well known by one of ordinary skill in the art at the time the invention was made that Internet electronic mail is TCP/IP standard for electronic mail service and this well known feature is clearly documented by Doughlas E. Commer's book titled "Internetworking With TCP/IP". Examiner enclosed a copy of chapter 25 of the book that specifically teach Electronic Mail in TCP/IP for reference (Appendix A, Commer,

section 25.6 TCP/IP Standards For Electronic Mail Service begins on page 438, and section 25.9 Simple Mail Transfer Protocol (SMTP) begins on page 440).

(D) Applicant argues that a reference cannot be modified to destroy its purpose.

As to point (D), Examiner has discussed in items (A)-(C) above; it is obvious to one of ordinary skill in the art at the time the invention was made that the combining of Cohn's teaching into Kraslavsky's invention enhance Kraslavsky's invention as discussed above.

(E) Applicant argues that electronic mail messages are not connection mode messages, the system would not use a connection mode of communication. Thus, it is completely improper to find that the combination of Kraslavsky and Cohn provide both a teaching in which an Internet electronic mail message is transmitted, and also under specific circumstances which are recited in the claims, a connection mode message is transmitted.

As to point (E), It is well known that the Internet provides both connection and connectionless mode of communication; however, Internet electronic mail message is supported by SMTP protocol using TCP connection protocol which is connection mode of communication as described in SMTP Simple Mail Transfer Protocol by Stevens' reference which was submitted by applicant (Appendix B, Stevens, SMTP: Simple Mail Transfer

Protocol pages 441-444). Connectionless mode of communication is well known that it does not provide return messages or acknowledgments. In the contrary, Internet electronic mail supported by SMTP protocol using TCP connection protocol provides acknowledgments and it clearly described by Stevens. Therefore, Kraslavsky and Cohn teach transmitting Internet electronic mail message, and also teach transmitting a connection mode message under specific circumstances.

4. Applicant's arguments filed on June 07, 1999 have been fully considered but they are not deemed to be persuasive.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu, whose telephone number is (703) 305-9650. The examiner can normally be reached Monday through Friday from 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank J. Asta, can be reached at (703) 305-3817.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark
"EXPEDITED PROCEDURE")

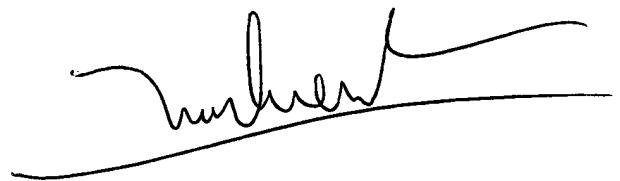
Or:

Serial Number: 08/738,659
Art Unit: 2756

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(703) 308-5359 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).



Le Hien Luu

Primary Examiner

December 21, 1999

LE HIEN LUU
PRIMARY EXAMINER